

III. REMARKS

1. Claims 1-14 remain in the application. Claims 1, 2, 8, 13 and 14 have been amended. Support for the amendment to claim 1 is found in the specification, for example, in Figure 4 and on page 4, line 30 through page 5, line 5. Support for the amendment to claim 2 can be found in the specification, for example in Figure 5 and on page 6, lines 1-8:

2. The specification was objected to as failing to provide antecedent basis for the claimed subject matter. The Office Action states: "the drawings and disclosure fails to support the electro-static discharge protector as an outer surface of the microphone."

Applicants respectfully request clarification of this objection. Applicant's find no claim to an outer surface of a microphone operating as an electro-static discharge protector.

3. Claim 9 has been amended to overcome the present informalities objection.

4. Claim 3 is definite and meets the requirements of the second paragraph of 35 USC 112.

Claim 3 is directed to a microphone structure according to claim 1 and recites that the electro-static discharge protector is on an outer surface of the microphone capsule.

The Office Action states that the claim is unclear because: "It is unclear as to what the applicant is inferring in respect to the position of the protector to the microphone capsule in respect drawing features the protector inside the capsule area."

Referring to Figure 5, an ESD protector (FTC) is clearly shown on the bottom of microphone capsule 500. Page 6, lines 3 and 4 of the specification state: "the structure comprises an ESD-protector FTC fastened according to invention on the bottom of microphone capsule".

Clearly, the electro-static discharge protector is shown and described in the figures and specification as "on an outer surface of the microphone capsule," as recited in claim 3.

5. Applicants respectfully submit that claims 1, 2, 8 and 10 are patentable over Applicant's admitted prior art in view of *In re Larson*.

Applicants respectfully submit that the admitted prior art fails to disclose or suggest at least one electro-static discharge protector connected between the output contacts of a microphone capsule and being located within the microphone capsule, as recited by claim 1.

Applicants also submit that the admitted prior art fails to disclose or suggest at least one electro-static discharge protector located on an outer surface of the microphone capsule as recited by claim 2.

Applicants further submit that the admitted prior art fails to disclose or suggest a first impedance in series between said first output conductor and said first output contact within the microphone capsule, as recited by claims 1 and 2.

Regarding the previous rejections, the Office Action correctly points out that the admitted prior art fails to disclose a first impedance within the microphone capsule.

Applicants reiterate that it would not have been obvious to add a resistor like R11 to circuitry within the microphone capsule because the admitted prior art teaches away from adding R11. The specification on page 2, lines 22-27, states that R11 may be added in series with one output conductor of the microphone capsule to decouple C11 and the external varistor VDR1. The specification goes on to describe why this is not a viable option. Described disadvantages of adding R11 include that it would have to be large enough to sustain an electro-static discharge (ESD) pulse, and that it may make the microphone more susceptible to ESD. Thus, not only is there no suggestion to add R11 to the present invention, the admitted prior art teaches away from adding R11.

6. Applicants again submit that *In re Larson* is not applicable to the present application.

On page 6 of the final Office Action, The Examiner states that Applicants argue that application of *In re Larson* is inappropriate because the decision is based on vehicular means. This statement mischaracterizes Applicants arguments. Applicants' statement that "it would appear that fluid transporting vehicles and brake drums have nothing to do with an integration of microphone structure" was merely an adjunct to Applicants' main argument.

In re Larson is widely quoted in Office Actions as holding "that the use of a one piece construction instead of the structure disclosed in the prior art would be merely a matter of obvious engineering choice" (See MPEP 2144.04 V. B. Making Integral) and is generally used in obviousness rejections that state that it would be obvious to make integral what had previously been made in separate parts.

Using *In re Larson*, the Examiner has concluded that, regarding the present microphone, "the use of one structure instead of a structure of multiple parts as that disclosed by the AAPA would be merely a matter of obviousness to one skilled in art of microphone structure and function".

Applicants main argument, reiterated here, is that the conclusion is erroneous because the point of law for which *In re Larson* is cited does not apply. Applicants are not simply making multiple parts integral. Applicants use a different configuration of parts that has remarkable advantages over the admitted prior art, as stated in the specification on page 3, line 23 through page 4, line 8.

Applicants submit that *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983), also cited in MPEP 2144.04 V. B. Making Integral, is more appropriate to the present application. In *Nortron*, Nortron Corporation argued that replacement of a bolted leaf spring and cross bar structure with a unitary rigid structure was obvious. The Court disagreed.

In its argument that the invention here is but making integral what had earlier been made in four bolted pieces, Nortron seeks to limit the focus of inquiry to a structural difference from the prior art and then to show that that difference alone would have been obvious. That effort is not proper under the statute, which requires that an invention be considered "as a whole," 35 U.S.C. § 103. As Judge Nixon recognized, "the emphasis on nonobviousness is one of inquiry, not quality". *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The inquiry here establishes that the present invention includes the inventor's elimination of the need for damping. Because that insight was contrary to the understanding and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art. *United States v. Adams*, 383 U.S. 39 (1966).

This case is much more analogous to the present application. In Nortron, Schenck's structure eliminated external resonance dampers. In the present application, the external protection circuitry has been eliminated. Applicants respectfully submit that the present invention does not simply integrate multiple parts, but that it uses a different, advantageous configuration of parts. Applicants note that the components have not been moved from the outside to the inside of the capsule, but that the number of components needed for protecting the microphone capsule from ESD and RF disturbances has been remarkably reduced.

Applicants further submit that the previous rejections fail to consider the wholeness of the invention. Several components are avoided, for example, circuits 110 and 130 (Figure 1). In the structure of the present invention the external protection circuitry has been eliminated.

At least for these reasons, applicants submit that claim 1 and its dependent claims are patentable over the admitted prior art in view of *In re Larson*.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

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24 Feb 2004

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